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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/578,224      | 05/24/2000  | Thomas Schwalbe      | CELL0013            | 4618             |

25268 7590 01/06/2006

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| EXAMINER |
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LEUNG, JENNIFER A

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1764

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/578,224 | <b>Applicant(s)</b><br>SCHWALBE ET AL. |  |
|                              | <b>Examiner</b><br>Jennifer A. Leung | <b>Art Unit</b><br>1764                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-18, 22-24, 26 and 77-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14, 16-18, 22-24, 26 and 77-80 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-24-05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Ex parte Quayle***

This application is in condition for allowance except for the following formal matters:

#### **IN THE SPECIFICATION:**

In Applicant's amendment submitted on May 4, 2005, the new paragraphs improperly added to page 25 of the specification should be deleted. (see page 2, line 16, to page 3, line 30, of the response). Appropriate correction is required.

#### **IN THE OATH/DECLARATION:**

This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The claimed subject matter is the "simple plate reactor" as described in U.S. Application Serial No. 09/496,999, to which the instant application is to form a Continuation-in-Part (CIP). [The parent application data should be entered into the box for "U.S. Parent Application Numbers(s)", within the section claiming benefit under 35 U.S.C. §120]. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

### ***Response to Arguments***

Applicant traversed the requirement for a new oath/declaration in the response submitted on October 24, 2005. Applicant argues (beginning on page 12, line 21),

"The present application, which is a continuation-in-part application based on the '999 application, was filed with a newly executed declaration (relative to the declaration filed in the '999 application... Clearly, the declaration originally filed in the present

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application is different than the declaration filed in the parent application, and applicants are not simply attempting to rely upon the same declaration filed in the '999 application. Thus, the requirement set forth in 37 C.F.R. 1.63(e) has already been met.”

The Examiner respectfully disagrees. As set forth under 37 CFR 1.67(b),

“A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented, or when an oath or declaration submitted in accordance with §1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.”

The instant application was changed on May 4, 2005 to a Continuation-in-Part (CIP) application, in which at least one claim was presented containing subject matter that was not substantially embraced in the statement of invention or the claims as originally filed on May 24, 2000. The subject matter of the “simple plate reactor” was merely referenced in an incorporation by reference of application 09/496,999 on page 15, lines 12-16, of the originally filed specification. None of the originally filed claims contained any of the subject matter of the “simple plate reactor” now being claimed. Additionally, the subject matter of the “simple plate reactor” was not substantially embraced in the statement of the invention because the declaration submitted on May 24, 2000 contains no indication of the parent application from which the subject matter of the “simple plate reactor” was obtained and, further, to which the benefit under 35 U.S.C. §120 is now being claimed. A new oath/declaration is thus required.

***Conclusion***


Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213. A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

\* \* \*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Leung whose telephone number is (571) 272-1449. The examiner can normally be reached on 8:30 am - 5:30 pm M-F, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer A. Leung  
January 4, 2005 

  
**HIEN TRAN**  
**PRIMARY EXAMINER**